

Appl. No.: 10/719,993  
Atty. Docket No.: CL1496ORD

Note that the Restriction Requirement listed claims 23 and 34 in Group VI. Applicants assume that the Examiner meant to include claim 24, instead of claim 23, in that group.

The Examiner also issued a further restriction requirement to all groups having more than one nucleotide polymorphism.

Applicants hereby provisionally elect, with traverse, to prosecute Group I, Claims 1-6, and 21-22, drawn to methods for identifying an altered risk for developing Alzheimer's diseases by detecting the presence of various SNPs, in particular, the polymorphism hCV8227677, also known as rs498055, as represented by SEQ ID NO.: 7368. More information on this polymorphism can be found in Table 2, Table 6, the Sequence Listing, and in the Example section starting from page 119.

For reasons stated below, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement, including the additional restriction requirement of the selection of just one polymorphism sequence for examination.

Under MPEP section 803, for a restriction requirement to be proper, the Examiner has a serious burden to make a *prima facie* case that the following two criteria are met:

- 1). The inventions must be independent or distinct as claimed; and
- 2). There would be a serious burden on the examiner if restriction is not required.

Applicants respectfully submit that the Examiner has not met the burden. Applicants submit that the search and examination of claims as encompassed by the various groups is not unduly burdensome. For example, a search of the prior art to determine the novelty of the polypeptides of Group III would provide information regarding the novelty of the methods for detecting such polypeptides of Group V, and for identifying an agent of Group VI, which binds to the polypeptides.

With respect to the specific polymorphism sequence election requirement, Applicants wish to draw the Examiner's attention to MPEP Section 803.04, which addresses restriction requirement relating to nucleotide sequences.

The Examiner's attention is directed to MPEP Section 803.04. See also *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996). There, while recognizing that nucleotide sequences "are deemed to normally constitute independent and distinct inventions", the Director "has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application" in the interest "to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office."

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The MPEP further announces that it "has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction." MPEP Section 803.04, Eighth Edition, Revision 3, August 2005.

Therefore, Applicants hereby respectfully request that the following ten (10) nucleotide sequences in Group I to be examined together. The ten sequences, together with their public identifiers, are shown in the table below. More detailed information about these ten sequences is found in the Table 2 and Table 6, and in the Sequence Listing.

	SNP Marker	RS NO.	SEQ ID NO.
1	hCV8227677	rs498055	7368
2	hCV2655167	rs3741916	15255
3	hCV2950452	rs2029721	40690
4	hCV1920609	rs2274159	37009
5	hCV8715115	rs2018621	35459
6	hCV299325	rs1057971	10077
7	hCV855979	rs600879	11511
8	hCV8921255	rs2008134	7338
9	hCV337151	rs4806173	28081
10	hCV2539346	rs12984928	28102

In the event the Examiner maintains the Restriction Requirement, Applicants reserve the right to request rejoinder of any process claims limited in scope to allowable product claims in accordance with *In re Ohtai*, and further reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications without prejudice.

The Examiner is invited to contact the undersigned via telephone if a phone interview would expedite the prosecution of the instant patent application.

Respectfully submitted,

By:

  
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